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REMARKS/ARGUMENTS

This amendment is responsive to the non-final Office Action issued May 23, 2003.

Claims 16-30 were rejected under §112(2) for a) being incomplete for omitting essential structural cooperative relationships of elements, and for b) defining an apparatus by its function. Reconsideration and withdrawal of these rejections are respectfully requested, for the following reasons.

Regarding a); namely claims 16-30 being incomplete, claim 16 has been amended so as to recite that the storage device is "coupled to said at least one processor", thus providing the requested structural cooperative relationship of elements between the recited processor and the recited storage device.

Regarding b); namely claims 16-30 defining an apparatus by its function, the Examiner's kind attention is respectfully drawn to Section 2106 of the MPEP drawn to the patentability and examination of computer-implemented inventions:

> "Determine Whether the Claimed Invention Complies with 35 U.S.C. 112, Second Paragraph Requirements
>
> Claims Setting Forth the Subject Matter Applicant Regards as Invention
>
> Applicant's specification must conclude with claim(s) that set forth the subject matter which the applicant regards as the invention. The invention set forth in the claims is presumed to be that which applicant regards as the invention, unless applicant considers the invention to be something different from what has been claimed as shown by evidence; including admissions, outside the application as filed. An applicant may change what he or she regards as the invention during the prosecution of the application.
>
> Claims Particularly Pointing Out and Distinctly Claiming the Invention
>
> Office personnel shall determine whether the claims set out and circumscribe the invention with a reasonable degree of precision and particularity. In this regard, the definiteness of the language must be analyzed, not in a vacuum, but always in light of the teachings of the disclosure as it would be interpreted by one of ordinary skill in the art.

Applicant's claims, interpreted in light of the disclosure, must reasonably apprise a person of ordinary skill in the art of the invention. However, the applicant need not explicitly recite in the claims every feature of the invention. For example, if an applicant indicates that the invention is a particular computer, the claims do not have to recite every element or feature of the computer. In fact, it is preferable for claims to be drafted in a form that emphasizes what the applicant has invented (i.e., what is new rather than old). *In re Dossel*, 115 F.3d 942, 946, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997).

A means plus function limitation is distinctly claimed if the description makes it clear that the means corresponds to well-defined structure of a computer or computer component implemented in either hardware or software and its associated hardware platform. *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999); *B. Braun Medical, Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997)."

The Examiner is respectfully urged to give the following examples given in the MPEP due consideration, as being directly applicable to claims 16-30:

"Such means may be defined as:

- a programmed computer with a particular functionality implemented in hardware or hardware and software;

- a logic circuit or other component of a programmed computer that performs a series of specifically identified operations dictated by a computer program; or

- a computer memory encoded with executable instructions representing a computer program that can cause a computer to function in a particular fashion."

It is, therefore, believed that the Office's own guidelines, as set forth in the MPEP, affirmatively condones the format of claim 16 and its dependent claims. In particular, claim 16 is drawn to a programmed computer with a particular functionality implemented in both hardware and software, as provided for above. Moreover, claim 16 defines a particular apparatus, not only in terms of structure, but also in terms of the functionality of the claimed apparatus, as specifically allowed by both §112(2) of the Patent Act and by the Patent Office's own guidelines, as memorialized in section 2106 of the MPEP. Reconsideration and withdrawal of the §112(2) rejections of claims 16-30 are, therefore, respectfully requested.

Claims 1-14, 16-29 and 31-44 were rejected as being unpatentable over Henson in view of Wilson. Reconsideration and withdrawal of these rejections are respectfully requested, for the following reasons.

At the outset, it is respectfully submitted that the primary reference does not teach or suggest any quote of any kind. In fact, the term "quote" does not even appear in the entire patent. The Henson patent teaches a Website enabling a customer to customize a computer that he or she wishes to purchase. No quotes are generated. The Henson reference, moreover, does not teach or suggest allowing modifications to any quote, nor does Henson teach or suggest converting a quote into an executable order, as no quotes are ever created.

The secondary reference fails to overcome this fundamental shortcoming of the Henson reference. Indeed, the Wilson tells us that:

> "OrderManager 4.2 lets users create <u>a request for</u> quote (RFQ) that can later be changed top an actual order or left to expire in a predetermined number of days, officials said. Sellers can respond with prices quotes that would be guaranteed for the life of the quote
>
> ...
>
> - RFQ can automatically be changed into an order" (<u>Underlining Emphasis Added</u>)

In Wilson, what is created is not a quote, but a <u>request</u> for a quote. Sellers can <u>respond</u> to these <u>requests</u> for quotes with price quotes that are guaranteed for the life of the quote. Moreover, there appears to be some undisclosed mechanism by which requests for quotes can be automatically changed into an order. This document also tells us that OrderManager 4.2 offers some undefined "quote management, configuration".

Consideration of the two cited references in combination, as is required in responding to a §103(a) rejection based upon a combination of references, yields the following. Even if the

Website and methods for providing customers with configured machines were to be combined with the teachings of Wilson, the present invention would not result, nor would the applied combination suggest the claimed inventions to the person of ordinary skill in the art. Indeed, such a combination would, somehow, let customers <u>request a quote</u> for a customer configured machine, to which the computer seller (e.g. Dell, the assignee of the Henson patent) may respond to with a price quote. Moreover, there might be some mechanism by which a <u>request</u> for a quote may automatically become an order. However, Wilson is entirely silent on how that may be accomplished. It is noteworthy that, in both applied references, quotes are discussed only in Wilson, and only in the above-reproduced five lines. The claimed inventions are <u>NOT</u> drawn to any means or methods by which requests for quotes become orders.

Wholly unsuggested by the applied combination are the following claimed steps:

> "**generating a first quote that includes an identification of the first item and the retrieved information;**
>
> **allowing modifications to be made to the first quote, the first quote lasting at least until a consolidation interval has elapsed, and**
>
> **converting the first quote to a first executable order when a quote conversion process determines that the first quote has remained unmodified at least for the consolidation interval.**"

Kindly note that:

- The applied combination does not teach or suggest any means, method or functionality for enabling customers to make any modifications to a generated quote, <u>as claimed</u>;

- The applied combination does not teach or suggest any consolidation period interval during which a generated quote may be modified, as claimed;

- The applied combination does not teach or suggest any means, method or functionality for converting a quote to an executable order, as claimed. What Wilson teaches is that, as of December 6, 1999, a product called OrderManager 4.2 was reported to have the ability to automatically convert a request for quote (RFQ) - **not a quote** - into an order.

- The applied combination does not teach or suggest any means, method or functionality for determining whether a generated quote has remained unmodified for at least the consolidation interval, as claimed.

A disclosure of a mechanism for creating a request for a quote that can be changed into an order or left to expire in a predetermined number of days (the Wilson reference) in combination with a disclosure of a Website and mechanism for allowing customers to configure PCs (Henson) simply does not support an obviousness rejection of the independent claims of the present application. For the foregoing reasons, there are no factual bases on which to conclude that the invention of claim 1 as a whole would have been obvious to a person of ordinary skill in the art. Moreover, the Office has not pointed to any specific passages in the applied combination that would tend to suggest any of the above-reproduced and discussed claimed steps or the inventions of the independent claims as a whole. For the foregoing reasons, therefore, reconsideration and withdrawal of the §103(a) rejections applied to claims 1-14, 16-29 and 31-44 are respectfully requested.

As the §103(a) rejections to the independent claims are deemed to have been overcome, it is not believed necessary to discuss the §103(a) rejections to the dependent claims 15, 30 or 45 in any detail.

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Applicant's attorney believes that no new matter has been introduced by the present amendment, that all claims are allowable as incorporating allowable subject matter and that the present application is now in condition for an early allowance and passage to issue. If any unresolved issues remain, Examiner Brown is respectfully invited to contact the undersigned attorney of record at the telephone number indicated below, and whatever is required will be done at once.

Respectfully submitted,

YOUNG LAW FIRM, P.C.

By: _____

Alan W. Young, Esq.
Attorney for Applicant
Registration No. 37,970
4370 Alpine Road, Suite 106
Portola Valley, CA 94028
Telephone: (650) 851-7210
Facsimile: (650) 851-7232

OFFICIAL

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